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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,437	02/21/2002	Francis James Canova JR.	25216-0906	9150

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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT PAPER NUMBER

2835

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/080,437

Applicant(s)

CANOVA ET AL.

Examiner

Michael V Datskovskiy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-10 and 41-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10 and 41-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 11/28/2003 have been fully considered but they are not persuasive. A reference may be used as prior art as of the filing date of a provisional application of which benefit is claimed under 35 U.S.C. § 119(e) or § 365(c) *only to the extent the provisional application provides 35 U.S.C. § 112, 1<sup>st</sup> paragraph support* for the part of reference relied upon in making the rejection. See, e.g., *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002). Conversely, if the provisional application does not provide support for the part of the reference relied upon to make a rejection, then the filing date of the provisional application cannot be relied upon as the § 102(e) date of the reference. In this case a provisional application 60/113,181 by Kim et al undoubtedly provides support for the part of the reference relied upon to make a rejection. (See included in this action copy of the provisional application).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 41-49, 55-57 and 59-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al.

Kim et al teach a hand held computer 124, Fig. 14, comprising: a housing having a midframe formed from a plurality of segments, the midframe forming part of an exterior of the housing and being at least partially exposed along one or more peripheral surfaces of the housing, the midframe having a first, 200 and a second, 202 accessory slots associated with a left and right sides of the midframe, respectively, the first and second accessory slots being substantially cylindrical, elongate and capable of receiving and accommodating at least one of the removable accessory devices – stylus or a spine 130 of a cover 100; a front shell coupled to a front side of the midframe; and a back shell coupled to a back side of the midframe, wherein the peripheral portion is formed from at least portions of the front shell and the back shell. Kim et al teach furthermore: said first and second accessory slots partially enclose the accessory device along a length of the accessory device, and a portion of the accessory device is exposed to an exterior of the hand held computer along substantially the length of the accessory device; a bottom of the housing is flared out and acts as a stop for accessory devices inserted into the accessory slots. Regarding to the claims 31-36: The method steps are inherently necessitated by the device structure, as Kim et al disclose it.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of Ozawa.

Kim et al teach all the limitations of the claims except said hand held computer further comprises an external port in communication with the first accessory slot, said external port having at least one external port contact, and the stylus has a plurality of contacts, which connect to the external port contacts when the stylus device is inserted into the first accessory slot. Ozawa teaches a hand held computer 1, Fig. 11, comprising: a housing; an accessory slot 3, the slot being substantially cylindrical, elongate and capable of receiving and accommodating a removable accessory device – stylus 4, wherein said hand held computer further comprises an external port in communication with the accessory slot, said external port having a plurality of external port contacts 68, and the stylus has a plurality of contacts 42, which connect to the external port contacts 68 when the stylus device 4 is inserted into the accessory slot 5. It would have been obvious to one ordinary skilled in the art at the time invention was made to employ in the device by Kim et al a held computer comprising an external port in communication with an accessory slot, said external port having at least one external port contact, and a stylus having a plurality of contacts, which connect to the external port contacts when the stylus device is inserted into the accessory slot, as it is shown by Ozawa, in order to create an electrical contact between said computer and said stylus. Regarding to the claims 37-38: The method steps are inherently necessitated by the device structure, as Kim et al and Ozawa disclose it.

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of Moller et al.

Kim et al teach all the limitations of the claims except said hand held computer accessory slots further each comprise a retaining device for retaining accessory devices. Moller et al teach a hand held computer comprising an accessory slot 26 having a retaining device 28 for retaining accessory device – stylus 12. It would have been obvious to one ordinary skilled in the art at the time invention was made to employ in the device by Kim et al a held computer comprising an accessory slots having each a retaining device for retaining accessory devices, as it is shown by Moller et al, in order to prevent said accessory devices for being lost. Regarding to the claim 10: Kim et al and Moller et al disclose the claimed invention except for that the notch 21 is located on the stylus and the detent 28 is located in the slot. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate a notch in a slot and a detent on a stylus, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

7. Claims 50-54 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of Saliba.

Kim et al teach all the limitations of the claims except at least a third (front) portion of the peripheral surface is formed from a material partially transmissive to infrared light,

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wherein said third peripheral portion is adjacent to a component producing said infrared light. Saliba teaches a PDA 50, Fig.1, comprising a component 53 producing infrared light, wherein said component is adjacent to the front peripheral portion of the PDA housing. Regarding to the material requirements claimed in claims 50, 53 and 58: It would have been obvious to one having ordinary skill in the art at the time the invention was made to make a part (window) covering said infrared light trasmissive to said light (polished if necessary) since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Datskovsky whose telephone number is (703) 306-4535. The examiner can normally be reached on Mn - Fry 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren E. Schuberg can be reached on (703) 308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Primary Examiner

Michael Datskovsky



December 18, 2003